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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,121	06/15/2001	Pierre N. Fay	404-193.016-1	8258

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EXAMINER

SANDERS JR, JOHN R

ART UNIT	PAPER NUMBER
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3737

11

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/883,121

Applicant(s)

FAY ET AL.

Examiner

John R. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The declaration filed on 02 January 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the *Foley* '223 reference.
2. When a claim in a patent application is rejected, "the inventor of the subject matter of the rejected claim... may submit an appropriate oath or declaration to establish invention of the subject matter... on which the rejection is based." See 37 CFR 1.131(a). The inventive entity of the instant application consists of two individuals, only one of which has signed the submitted declaration. Admission is made in the declaration that the second inventor has no knowledge of and has not been contacted with regard to the submitted declaration, and as such the declaration cannot be accepted without proper signing by the inventive entity.
3. Furthermore, the explanation of the lack of evidence submitted is considered unsatisfactory and therefore the declaration is considered ineffective. See 37 CFR 1.131(b). Since no evidence has been submitted, the declaration is insufficient to establish a conception of the invention prior to the effective date of the *Foley* '223 reference.

### ***Response to Arguments***

4. Applicant's arguments filed 02 January 2004 have been fully considered but they are not persuasive. See remarks section below.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,095,650 to *Gao et al.* in view of U.S. Patent No. 6,535,223 to *Foley*.**

7. *Gao* discloses an interactive eyewear selection system (FIG. 1) including an imaging device (18) for capturing an image of a customer's face, a display screen (26) for both product selection and displaying a composite image, information receiving means (28, 30), and an image generating means (38) for superimposing the image of the customer's face with that of a trial frame (col. 6: 14-23). *Gao* discloses determining facial parameters such as pupil centers, intraocular distances and face edges (col. 8: 5-10) and using these parameters to scale the frame image to the face image (col. 10: 29-37). *Gao* discloses determining facial parameters in a location remote from the location of the eyewear via the Internet (col. 10, 19-22).

8. *Gao* does not disclose expressly using the invariant diameter of the iris as a reference for determining the size of a facial feature of the customer, nor does *Gao* disclose expressly counting the number of pixels to measure the iris and facial features.

9. *Foley* discloses the iris diameter as a reference object (abstract; col. 2: 43-45). *Foley* also discloses measuring the number of pixels across the reference object (abstract; col. 2: 60-65). *Gao* and *Foley* are analogous art because they both deal with the problem of determining size and scale factors concerning facial features and digital photographs.

10. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the iris as a reference object and to make measurements of digital images using

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pixel units. The suggestion/motivation for doing so would have been due to the fact that, (a) the iris is of substantially constant diameter from person to person, and (b) pixel measurements are commonly made in digital imaging when distance in an image is unknown; using different units in a scale ratio does not alter the value of the ratio. Therefore, it would have been obvious to combine *Foley* with *Gao* to obtain the invention as specified in claims 1-17.

### ***Remarks***

11. Applicant has respectfully submitted that the combination of the references by Examiner in Paper No. 8 would not render the present application obvious because the suggestion and motivation to combine the references are not found in the prior art; rather, they are formulated in hindsight by the Examiner. Applicant asserts, "The mere fact that iris size is uniform in humans, and the fact that pixel measurements are common in digital imaging, do not suggest the desirability of combining the *Gao* and *Foley* references." Examiner respectfully disagrees.

12. Examiner, in his Office Action, has stated the deficiency of *Gao* as not containing the step of using the iris diameter as a reference for a scale measurement of facial features of a customer or the expression of distance in an image as a number of pixels. *Gao* does disclose that a reference object be used that is of known size for purposes of calibration (col. 7, lines 35-57). *Foley* discloses using the iris as a reference for a scale determination in an apparatus *expressly disclosed* as a means for determining distances in an image for purposes relating to the measurement of pupillary distance (a facial feature) and for properly sizing and superimposing an image of eyeglass frames over the image of a person's face (see *Foley*, claims 1-31). *Foley* uses pixel count measurements to arrive at the scale ratio used for determining proper distances.

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The fact that *Gao* and *Foley* both disclose systems for superimposing eyewear onto an image of a customer, wherein a reference object is used for calibration of the system, is a motivation to combine the references in the manner described in Examiner's Office Action.

13. Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (703) 305-4974.

The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis W. Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JRS

  
**DENNIS W. RUHL**  
**SUPERVISORY PATENT EXAMINER**